



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,287	11/28/2005	Aki Vanhatalo	P4808US00	9403
11764 7590 03/08/2011 Ditthavong Mori & Steiner, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER				
CASCA, FRED A				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
03/08/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary

Application No.

10/538,287

Applicant(s)

VANHATALO, AKI

Examiner

FRED A. CASCA

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment filed on June 23, 2010. Claims 1-7, 8-13 and 16-20 are still pending in the present application. **This Action is made FINAL.**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7, 13 and 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 8, 16 and 17 have been amended to contain new matter. The phrase "a voice mailbox associated with the telephone number" added to independent claims 1, 8, 16 and 17 has not been described in the specification.

Further, the amended phrase, "the multimedia message includes an identifier to indicate that the multimedia message is created as a response to a failed attempt" as amended in claim 2 is not found in the specification. Further, the new claim 18 containing, the phrase "wherein the multimedia message is converted by a messaging server to a voice mail for delivery to the voice mail box" is not found in the specification. Further, the new claim 19 containing, the phrase

“wherein the multimedia message is converted by a messaging server to a voice mail for delivery to the voice mail box” is not found in the specification. Further, the new claim 20 containing, the phrase “wherein the multimedia message is forwarded to a web page associated with the receiver” is not found in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez et al (US 2003/0147373) in view of Hymel (US 2003/0216137 A1) and further in view of Castell et al (US 7,283,808).

Referring to claim 1, Pelaez discloses a method (abstract and figure 1) comprising:

determining to establish, at a device, a connection with a receiver using a telephone number (Fig. 3 step 300, “a call is received from a user of a first device to a user of a second device”, note that a call is received, the user of the first device must have used a telephone number to make the call, thus determining to establish a connection at the first device),

as a response to a failed attempt for establishing the connection (Par. 23, Fig. 3 step 302, “is the second device available”, note that the unavailability of the second device is commonly associated with failed attempt for establishing the connection),

starting at the device, a multimedia messaging service (MMS) (figure 3 step 304-308, and paragraph 5, and Par. 23, particularly Par. 23, lines 9-14, “provide option to user of the first device to send a multimedia mail message,” “send a multimedia mail message”, note the user of the first device is provided an option to user multimedia mail message, thus the multimedia messaging service is stated at the device of the first user. Further note that in figure 3, steps 304-308 are equivalent to “starting a multimedia message service (MMS)”, particularly as described in Par. 23, the step of providing the first user with an option to send a multimedia mail message is equivalent to the start of a multimedia messaging service)

and activating a recording function of a sound clip (figure 3 and paragraphs 5 and 12, “voice”),

and transmitting the created multimedia message to the receiver (paragraph 5, lines 24-25, and Par. 26, lines 12-14, “user of the second device retrieves the message”).

Pelaez does not specifically disclose determining to record a voice message to be included as part of a multimedia message in memory of the device.

Hymel discloses determining to record a voice message to be included as part of a multimedia message in memory of the device (paragraph 17-22 and figures 1-4).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Pelaez in the format claimed by applicant by incorporating the teachings of Hymel, for the purpose of providing convenience to users, saving time and using bandwidth efficiently, and thus providing an efficient messaging system.

Pelaez further discloses that the multimedia mail message is stored until the user of the second device retrieves, thus, there must be association between the location that the message is stored and the telephone number. the multimedia automatically (par. 5). However, Pelaez does not specifically disclose a "voice mail box associated with the telephone number," as claimed.

In an analogous art, Castell discloses voice mail box associated with the telephone number in order for call receiving devices to obtain messages stored for them (Col. 3, line 40-Col. 4, line 22, Col. 4, line 55-Col.5, line 9, and claims 6, 24 and 42, "voice mail box associated with a use of the wireless device").

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the combination in the format claimed by applicant for the purpose of providing convenience to users, saving time and using bandwidth efficiently, and thus providing an efficient messaging system.

Referring to claim 2, the combination of Pelaez/Hymel/Castell disclose the method of claim 1 and further disclose an identifier (inherent) in the multimedia message by which the message can be identified as claimed by applicant (Pelaez, Fig. 3, Par. 5 and 23-26).

Referring to claim 3, the combinations of Pelaez/Hymel/Castell disclose the method of claim 1 and further disclose in addition to the sound clip, one or a combination of the following is attached in the multimedia message: text, picture, and video image (Pelaez, paragraphs 12 and 14, "audio, voice, video," "text").

Referring to claim 4, the combinations of Pelaez/Hymel/Castell disclose the method of claim 1, and further disclose the step of automatically transmitting the message containing the sound clip to the receiver (Palaez, Fig. 3, and Natsumo, Fig. 8).

Referring to claim 6, the combinations of Pelaez/Hymel/Castell disclose the method of claim 1, and inherently disclose the message transmitted is the number to which the original request for connection is made (Palaez, Fig. 3, and Natsumo, Fig. 8. Also see the rejection of claim 1).

6. Claims 5, 7 and 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez et al (US 2003/0147373) in view of Hymel (US 2003/0216137 A1), further in view of Castell (US 7,283,808) and further in view of well known prior art (MPEP 2144.03).

Referring to claim 5, the combinations of Pelaez/Hymel/Castell disclose the method of claim 1.

The combination is silent on whether or not the step of transmitting to the receiver is as a response to a confirming function as claimed.

The examiner takes official notice of the fact that transmitting as response to a confirming message is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Pelaez in the format claimed by applicant for the purpose of providing an efficient messaging system.

Referring to claim 18 the combinations of Pelaez/Hymel/Castell disclose the method of claim 1.

The combination is silent on whether or not the multimedia message is converted by a messaging server to a voice mail for delivery to the voice mail box.

The examiner takes official notice of the fact that multimedia message being converted by a messaging server to a voice mail for delivery to the voice mail box is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Pelaez in the format claimed by applicant for the purpose of providing an efficient messaging system.

Referring to claim 19, Pelaez disclose the method of claim 1.

The combination is silent on whether or not the multimedia message is being forwarded to a web page associated with the receiver.

The examiner takes official notice of the fact that the multimedia message being forwarded to a web page associated with the receiver is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Pelaez in the format claimed by applicant for the purpose of providing an efficient messaging system.

Referring to claim 20, the combinations of Pelaez/Hymel/Castell disclose the method of claim 1.

The combination is silent on whether or not the determination to transmit the multimedia message to the voice mail box is made after determining that the receiver is unable to receive the multimedia message.

The examiner takes official notice of the fact that the determination to transmit the multimedia message to the voice mail box is made after determining that the receiver is unable to receive the multimedia message is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Pelaez in the format claimed by applicant for the purpose of providing an efficient messaging system.

Referring to claims 8-13 and 16-17, claims 8-14 and 16-17 are rejected for the same arguments/reasons that were made in the rejection of claims 1-7 above.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7, 8-13 and 16-20 have been fully considered but they are moot in view of new grounds of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard, can be reached at (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

Application/Control Number: 10/538287

10

Art Unit: 2617

/Patrick N. Edouard/

Supervisory Patent Examiner, Art Unit 2617